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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Gregor Specht

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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01/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,905	Applicant(s) SPECHT, GREGOR	
	Examiner LAWRENCE D. FERGUSON	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed September 25, 2008.

Claims 1, 4-8, 10-13 were amended, claim 14 was cancelled and claims 15-17 were added rendering claims 1-13 and 15-17 pending, with new claims 15-17 withdrawn as a non-elected invention.

Information Disclosure Statement

2. The references disclosed within the information disclosure statement (IDS) submitted on September 25, 2008, have been considered and initialed by the Examiner.

Restriction

3. Newly submitted claims 15-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: A vehicle is a different invention than a component.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections – 35 USC § 102(b)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohrmoser (U.S. 5,690,349).

Rohrmoser discloses a shell shaped basic member (2) and a core element (6), where the basic member (2) has at least one closing seam (13) and is connected to the core by at least one tolerance compensating intermediate layer (33, 34, 35) (column 1, line 67 through column 2, line 11; column 4, lines 19-23; column 5, line 57 through column 6, line 5; column 8, lines 45-53 and Figure 2). The shell comprises layers which includes a reinforcement layer, which is made of metal (column 2, lines 1-8 and column 3, lines 10-12). Figure 2 shows the core element (6) is configured to be an air stream conducting member. In claim 1, the phrase, “for a vehicle or an aircraft” is an intended use.” A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

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prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963), as in claim 1.

Concerning claim 2, the basic member (2) is formed in a multi-part manner (column 2, lines 1-12).

Concerning claim 3, the closing seam (13) has at least one joining location (Figure 2) where (2) and (13) are joined.

Concerning claim 4, the phrase, "a joining method, in particular welding, soldering, adhesive bonding, double-bend joining and/or riveting" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims. If the joining method is a critical feature, Rohrmoser discloses an adhesive layer bonds the closing seam (13) and the basic member (2) (column 7, lines 47-56).

Concerning claim 5, the bonded component has a closing seam thickness which corresponds to the thickness of the closed basic member (2). Because Applicant has not disclosed a particular thickness for the basic member or for the closing seam, any thickness would meet the claim limitation, where it is inherent that the basic member and closing seam have a thickness. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA

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1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987).

Concerning claim 7, the basic member is partially perforated with fastening elements (59) (column 11, lines 56-60 and Figure 7).

Concerning claim 8, integrations (33) are provided at the joining locations (column 8, lines 46-50 and Figure 2).

Concerning claim 9, the core element (6) comprises a plastic element (33) (column 8, lines 46-50 and Figure 2).

Concerning claim 10, the intermediate layer (13) comprises bonding agents (column 7, lines 51-54).

Concerning claim 11, interconnects are interpreted as being additional elements (33) and/or additional elements (59) (Figures 2 and 7).

Concerning claim 12, the intermediate layer (13) is located on the inner side of the cross-sectioned open basic member (2) and core element (6) is applied to the intermediate layer and basic member is closed and connected along a closing seam (2, 13) by means of an adhesive (column 7, lines 50-56 and Figure 2). In claim 12, the phrase, "for a vehicle or an aircraft" is an intended use." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Concerning claim 13, interconnects are interpreted as being additional elements (33) and/or additional elements (59) (Figures 2 and 7).

Claim Rejections – 35 USC § 103(a)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (U.S. 5,690,349).

Rohrmoser does not disclose a closing seam thickness ten times the thickness of the closed basic member. Although Rohrmoser does not specifically disclose the closing seal material has a thickness ten times the thickness of the closed basic member, thickness is an optimizable feature. In the absence of any evidence to the contrary, it would have been obvious to one of ordinary skill in the art to optimize the closing seal material of the component because discovering the optimum or workable

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range involves only routine skill in the art. The thickness directly affects the durability of the component. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

Additionally, there is also no clear teaching away from the claimed thickness of the closing seal material by Rohrmoser, as the reference does not exclude any thicknesses for the closed seal material. It would have been obvious to one of ordinary skill in the art for the closing seal material of Rohrmoser to be ten times thicker than the basic member, because the close seal is the primary location where the component is bound together, so the close seal would necessarily need to be much thicker (about ten times thicker) than the basic member to hold the component together and to withstand environmental forces during use.

Response to Arguments

8. The objection of the abstract is withdrawn due to Applicant submitting a replacement abstract on a separate sheet.

The rejection made under 35 U.S.C. 112, second paragraph is withdrawn due to Applicant amending claims 5-6 to make them more definite and cancelling claim 14.

The rejection made under 35 U.S.C. 101 is withdrawn due to Applicant cancelling claim 14.

The rejection made under 35 U.S.C. 102(b) as being anticipated by Rohrmoser (U.S. 5,690,349) is withdrawn due to Applicant amending claim 1 to include "wherein

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the basic member is metal and at least one core element is configured to be an air stream conducting member for a vehicle or an aircraft."

Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (U.S. 5,690,349) have been considered but are unpersuasive. Applicant argues the cited art does not disclose at least one core element that is configured to be an air stream conducting member for a vehicle or an aircraft. Figure 2 of Rohrmoser shows the core element (6) is configured to be an air stream conducting member. In claim 1, the phrase, "for a vehicle or an aircraft" is an intended use." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant further argues the reference does not disclose a basic member that is metal. The shell comprises layers which includes a reinforcement layer, which is made of metal (column 2, lines 1-8 and column 3, lines 10-12).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil, can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/
Patent Examiner, Art Unit 1794

/Bruce H Hess/
Primary Examiner, Art Unit 1794